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Hyun-Wook Cho

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EXAMINER

CHANKONG, DOHM

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/584,239	Applicant(s) CHO ET AL.	
	Examiner DOHM CHANKONG	Art Unit 2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This final rejection is in response to Applicant's arguments filed on 5/20/2011. Applicant amends claim 13 and presents claims 1-19 for further examination.

I. RESPONSE TO ARGUMENTS

As a preliminary matter, Applicant makes a statement in the remarks that renders claim 1 confusing. Applicant states that "[s]ince the terminal identification information is unique to each of the terminals, there will not be a match [between the terminal identification information]" (emphasis in original). If this statement is accurate, then the comparing step found in claim 1 is meaningless.

Claim 1 recites that a first terminal transmits contents with terminal identification to a second terminal and then making a comparison between the terminal identification attached to the contents with the terminal identification of the second terminal. If Applicant's statement is correct, then this comparison step is not necessary because each terminal has a unique terminal identification. The examiner requests an explanation as to why this comparing step is necessary.

Moving to Applicant's remarks, Applicant argues that *Colvin* fails to disclose the limitations in independent claims 1, 9, and 13. Specifically, Applicant argues that *Colvin's* authentication code is not analogous to the claimed terminal identification. Applicant's arguments are not persuasive for the following reasons.

There is no claim language in Applicant's claims that require interpreting the claimed terminal identification information as being unique to each terminal. As stated above, to interpret the terminal identification information as being unique to each terminal would render

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the comparing step in claim 1 useless. Moreover, the term "terminal identification information" is broad and subject to a variety of interpretations. *Colvin*'s authentication code reads on one possible interpretation for "terminal identification information."

Specifically, *Colvin* discloses that the authentication code includes hardware or device specific information [0105, 0108]. Because the code contains hardware information, it is reasonable to interpret the code as being "terminal identification information." There is no other claim language that contradicts this interpretation.

Applicant further argues that the claimed invention does not require incorporation of personal information or other device registration information. Whether the claimed invention does or does not require incorporation of personal information is not the point of the claim analysis. What matters is what is required in Applicant's claims and in particular the claim language.

Here, Applicant's claim language does not prevent interpreting *Colvin*'s inclusion of personal information or device registration information into the authentication code as reading on the claimed "terminal identification information." That is, there is no claim language stating that personal information or device registration information cannot be entered as part of the terminal identification information. Applicant should amend the claim to include limitations further describing the function of the terminal identification information in a manner that differentiates from *Colvin*'s authentication code.

Applicant also argues that *Colvin*'s "authentication code does not change after it is created." Based on this assertion, Applicant concludes that "it would not be possible for *Colvin*" to perform the comparing step. The examiner is not clear as to how Applicant arrived at this

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conclusion. *Colvin* clearly states at figure 3, item 172 and paragraph 113 comparing the authentication code attached to contents from a first terminal with registration information (i.e., terminal identification information) of a second terminal. *Colvin* at 301 discloses that the comparison may require an identical match between user registration and authentication code.

Similar remarks apply to Applicant's arguments for claims 9 and 13. For the foregoing reasons, Applicant's arguments are not persuasive. The rejections as set forth in the previous action are therefore maintained.

II. CLAIM REJECTIONS – 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

A. Claims 1-4, 9, and 13-17 are rejected under 35 U.S.C. § 102(e) as being anticipated by *Colvin*, U.S. Patent Publication No. 2004/0107368.

Claim 1

Colvin discloses a method of storing and reproducing contents, comprising the steps of: connecting to a contents server [Fig. 2 «item 140»: disclosing a user or user system may contact a remote server], downloading contents from the contents server [Fig. 2 «item 152»: disclosing that the user may utilize the content from the server], and storing the downloaded contents along with terminal identification information of a first terminal by the first terminal

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[0110: disclosing the files are copied to local storage | 0108, 0109: disclosing that authentication codes may be attached to each file where the authentication code includes hardware or device specific information];

transmitting the contents with the terminal identification information to a second terminal by the first terminal [0108: disclosing transferring the content to an "unauthorized system" (i.e., a second terminal) | Fig. 2 «item 152», 0129: disclosing the user (i.e., a first terminal) may transfer the files]; and

comparing the terminal identification information attached to the contents with terminal identification information of the second terminal [Fig. 3 «items 172, 174»] and if the terminal identification information is identical, reproducing the contents by the second terminal [Fig. 3 «item 178» | 0143: disclosing that "a portion of this information [hardware identifier] must match the originally authorized machine or device for the digital content file to subsequently be operable" | 0201: disclosing that "the user may be allowed to transfer, install, or otherwise copy the protected content"].

Claims 2, 3, 14, and 15

As to claims 2 and 3, *Colvin* discloses the step of performing a non-reproduction operation on the contents by the second terminal, if the terminal identification information attached to the contents is different from the terminal identification information of the second terminal, wherein the step of performing the non-reproduction operation comprises the step of deleting the contents [Fig. 3 «items 174, 176, 220»: disclosing deleting the file if the identification information do not match].

Claims 14 and 15 are rejected for at least the same reasons set forth for claims 2 and 3.

Claims 4, 16, and 17

As to claim 4, *Colvin* discloses wherein the step of performing the non-reproduction operation comprises the step of:

connecting to the contents server and registering the contents to be reproduced [0130: disclosing providing need and means to obtain a valid license | 0156: disclosing that the user device "may be required to supply additional registration information"];

updating the terminal identification information attached to the contents with the terminal identification information of the second terminal, if the contents registration is completed [0157]; and

deleting the contents if the contents registration is not completed [0130: deleting the files if the files are not authorized (i.e., the files were not properly registered)].

Claims 16 and 17 are rejected for at least the same reasons set forth for claim 4.

Claim 9

Colvin discloses a method of storing contents in a terminal, comprising the steps of: connecting to a contents server and downloading contents [Fig. 2 «items 140, 152»]; reading preliminarily stored terminal identification information [Fig. 2 «item 172»]; and storing the downloaded contents together with the read terminal identification information [0110: disclosing the files are copied to local storage | 0108, 0109: disclosing that authentication codes may be attached to each file where the authentication code includes hardware or device specific information].

Claim 13

Colvin discloses a method of reproducing contents in a terminal, comprising the steps of:

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checking terminal identification information attached to stored contents [Fig. 2 «item 172»];

comparing the terminal identification information attached to the contents with terminal identification of the terminal [Fig. 2 «item 172»]; and

reproducing the contents, the terminal identification information attached to the contents with terminal identification information of the terminal [Fig. 3 «item 178» | 0143: disclosing that "a portion of this information [hardware identifier] must match the originally authorized machine or device for the digital content file to subsequently be operable" | 0201: disclosing that "the user may be allowed to transfer, install, or otherwise copy the protected content"].

III. CLAIM REJECTIONS – 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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- A. Claims 5, 6, 18, and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Colvin* in view of *Pou* et al., U.S. Patent Publication No. 2005|0004873 [*“Pou”*].**

Claims 5 and 18

Colvin as modified by *Pou* discloses the contents registering step comprises the steps of: connecting to the contents server [Fig. 2 «item 140»], requesting registration of the contents to the contents server [0107: providing registration information to the server], and transmitting identification information of the contents to the contents server [0107: transmitting hardware specific information to the server];

displaying charge information of the contents if the contents charge information is received from the contents server [*Pou*, Fig. 7 «item 720» | 0056: disclosing displaying license terms and payment options (i.e., charge information) upon receiving the information from the server]; and

notifying the contents server of purchase willingness, if purchase of the contents is requested by a predetermined manipulation [*Pou*, 0056: notifying the user when the user accepts the license].

As noted above, *Colvin* does not expressly disclose features related to the charge information. However, such features were well known in the art at the time of Applicant's invention as evidenced by *Pou*.

In a similar field of invention to *Colvin*, *Pou* is directed to a system for distributing and managing rights of digital content. *Pou* further discloses displaying charge information such as license terms and payment options received from a server and allowing the user to accept or decline (i.e., purchase willingness) the charges [*Pou*, 0056].

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It would have been obvious to one of ordinary skill in the art to have modified *Colvin*'s content distribution system to include the charge related features taught in *Pou*. *Pou*'s charge features would improve *Colvin*'s system by allowing users to control when and how files are purchased [see *Pou*, 0056].

Claims 6 and 19

Colvin as modified by *Pou* discloses receiving an acknowledgement signal for the contents identification information [*Pou*, Fig. 6 «item 645»] and receiving an acknowledgement signal for the purchase willingness from the contents server [*Pou*, Fig. 7 «item 750»].

See rejection of claim 5 for reasons and motivation to combine *Colvin* and *Pou*.

B. Claims 7 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Colvin* in view of *Ono*, U.S. Patent Publication No. 2002/0016846.

Colvin as modified by *Ono* discloses the contents downloading step comprises the steps of:

connecting to the contents server, receiving a table of contents from the contents server, and displaying the table of contents [*Ono*, Fig. 4 «items 421, 423, 433» | 0009: displaying the service menu (i.e., table of contents) to the terminal]; and

notifying the contents server of contents selected by a predetermined manipulation among the table of contents and downloading the selected contents from the contents server [*Ono*, 0009: disclosing the user selects a file for downloading from the service menu].

As noted above, *Colvin* does not expressly disclose the features related to the table of contents. However, such features were well known in the art at the time of Applicant's invention as evidenced by *Ono*.

In a similar field of invention to *Colvin*, *Ono* is directed to a system for controlling distribution of content using licenses [*Ono*, abstract]. Further similar to *Colvin*, *Ono* discloses a user system downloading content from a server [*Ono*, Fig. 1]. *Ono* further discloses transmitting a menu to a terminal to enable a user to select files for downloading [*Ono*, 0009].

It would have been obvious to one of ordinary skill in the art to have modified *Colvin*'s content distribution system to include the menu features taught in *Ono*. Such a modification to *Colvin*'s system is an example of applying a known technique (*Ono*'s transmission of a file menu to a user to enable selection of files) to a known system (*Colvin*'s content distribution management system) ready for improvement to yield predictable results. *See* MPEP § 2143.

C. Claims 8, 10, and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Colvin* in view of *Ong*, U.S. Patent Publication No. 2003/0195851.

Claim 8

Colvin as modified by *Ong* discloses the terminal identification information is filled in a header field of a format of the contents [*Ong*, 0032: disclosing a file includes a header for the identifier of a portable player (i.e., terminal identification information)] and includes an ESN (Electronic serial number) of the terminal [*Colvin*, 0107: disclosing hardware specific information includes an electronic serial number].

As noted above, *Colvin* does not expressly disclose that the terminal identification information is filled in a header field of a format of the contents. However, such a feature was well known in the art at the time of Applicant's invention as evidenced by *Ong*.

In a similar field of invention as *Colvin*, *Ong* is directed to a system for managing distribution of content. Similar to *Colvin*, *Ong* discloses transmitting terminal identification

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information with content in order to verify that the content is usable by the device [*Ong*, 0032].

Ong further discloses that the terminal identification information is included in the header of the content [*Ong*, 0032].

It would have been obvious to one of ordinary skill in the art to have modified *Colvin*'s system to include the feature of including terminal information into the header of the content as taught by *Ong*. Such a modification to *Colvin*'s system is an example of applying a known technique (*Ong*'s placement of the terminal information into a content header) to a known system (*Colvin*'s content distribution management system) ready for improvement to yield predictable results. *See* MPEP § 2143.

Claim 10

Claim 10 is rejected for at least the same reasons set forth for claim 8.

Claim 12

Colvin as modified by *Ong* discloses the terminal identification information includes an ESN (Electronic serial number) of the terminal [*Colvin*, 0107: disclosing hardware specific information includes an electronic serial number].

IV. CONCLUSION

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday to Friday [10 am - 6 pm].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thu Nguyen can be reached on (571)272-6967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DOHM CHANKONG/
Primary Examiner, Art Unit 2452